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| 10/581,232 | 12/11/2006 | Horst Lang | 30071/41865 | 9144 |
| 4743 | 7590 | 01/05/2009 | EXAMINER | |
| MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606 | | | | PARADISO, JOHN ROGER |
| ART UNIT | | PAPER NUMBER | | |
| 3721 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/581,232 | LANG ET AL. | |
| | Examiner | Art Unit | |
| | John Paradiso | 3721 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 September 2008.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,2 and 4-7 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1,2 and 4-7 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over HEARD ET AL (US 5996311) in view of PICKEL ET AL (US 6354427).

HEARD ET AL discloses a device for screwing a cap (77) onto a container (12). A closing head (70) is surrounded by a hysteresis ring and permanent magnets, which rotate as the cap is screwed onto the container. (see column 3 lines 24-50, column 5 lines 15-47, and figures 1-2.). A control unit rotates a cam (84) around a track, governing the movement of the push rod (20) (see Fig. 2).

HEARD ET AL does not disclose the closing head as using grippers.

PICKEL ET AL discloses a container handling device with gripping units (24) consisting of tong grippers (24, 28) that are moved by means of cam tracks (see Fig. 1 and column 3:18-33 and 3:48-4:11). The grippers (28) are actuated by a push rod (48) which is moved by a control unit comprising a cam (46) which follows in a cam track (47) and moves arm (44) (see Fig. 3 and Fig. 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of HEARD ET AL by using the grippers of PICKET ET AL and their associated control units in order to more delicately grip the caps.

Response to Arguments

3. Applicant's arguments filed 9/23/2008 have been fully considered but they are not persuasive.

4. Applicant states on page 4 of his Response that "As was previously argued by Applicants in the response to the Office Action mailed on June 27, 2007, the adapter (76) of Heard et al. is not opened and closed in a controlled manner, as recited in amended claim 1, because the adapter (76) does not have moving parts that can be opened or closed. Additionally, Heard et al. does not disclose a 'control element allocated [to each gripping tong] to revolve therewith'"
However, this is remedied by the combination of HEARD ET AL with PICKEL ET AL. PICKEL ET AL does disclose grippers that open and close by means of a control unit with a cam and a push rod for each gripper, as described in the rejection above.

5. Applicant states on page 5 of his Response that "The device of Pickel et al., however, does not disclose or suggest several elements of amended claim 1. For example, the device of Pickel et al. does not disclose or suggest a gripping tong which can be moved on and off in a controlled manner, as recited in amended claim 1. To the contrary, the clamp (24) of Pickel et al. is not controlled to move, but merely moves in reaction to an externally applied force. The specification of Pickel et al. even states that "[t]he clamps (24) are operated *directly* by the bottles (1)." *See* col. 4, lns. 18-20".

However, Applicant is misconstruing the meaning of the word "directly" as used in context in PICKEL ET AL: it is clear from Fig. 1 and Fig. 3 of PICKEL ET AL that the cam (46) follows in the cam track (47), moving the control arm (44), which in turn moves the push rod (48) which opens and closes the grippers. What PICKEL ET AL referred to as the clamps being "operated directly by the bottles" is the manner in which the bottles are "handed off" from one rotary wheel to another: the grippers aren't opened wider than the neck of the bottle and then closed over the bottle neck, but rather the bottle is pushed into the gripper which is opened, but not quite as wide as the bottle neck,—and then the gripper is closed, providing a solid grip on the bottle. This is done in much the same way that a person might hand a bottle on another person, the first person maintaining a light grip on the bottle until the second person has got a good grip on the bottle, so as to avoid fumbling it between them.

Examiner maintains that the combination of HEARD ET AL and PICKEL ET AL discloses the claimed features of the instant invention. Applicant is also reminded that during patent examination of the claims, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321

(Fed. Cir. 2005). *See also* MPEP § 2111. Moreover, while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, *this is not the mode of claim interpretation to be applied during examination*. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). *See also* MPEP § 2111.01.

6. Applicant states on page 6 of his Response that “In addition to not disclosing a control unit, Pickel et al. does not disclose a cam that rotates relative to a rotor, as recited in amended claim 1. The device of Pickel et al. utilizes a cam mechanism comprising a cam roller (49) which engages a grooved cam (50) to move the sliding part (48) in the radial direction. *See* col. 3, lns. 61-65. The cam (50) of Pickel et al., however, does not rotate relative to the rotor. Instead, the grooved cam (50) remains stationary and the angle lever (44) and the attached cam roller (49) rotate. *See* col. 3, lns. 61-65. ¶ Additionally, the device of Pickel et al. does not disclose or suggest that a cam is coupled to a push rod that is displaced by the cam to activate the gripping tong, as recited in amended claim 1.”

However, as described in the rejection above, the claimed features are met by the combination of HEARD ET AL and PICKEL ET AL, since PICKEL ET AL discloses tong grippers (24, 28) that are moved by means of cam tracks (see Fig. 1 and column 3:18-33 and 3:48-4:11). The grippers (28) are actuated by a push rod (48) which is moved by a control unit comprising a cam (46) which follows in a cam track (47) and moves arm (44) (see Fig. 3 and Fig. 4).

7. Applicant states on page 7 of his Response that “ Specifically, the modification of the device of Heard et al. to use the grippers of Pickel et al. would render the device of Heard et al. inoperable for its intended purpose, and therefore the modification suggested by the examiner would not be obvious to one of skill in the art. *See* MPEP § 2143.01 V. Heard et al. discloses a cylindrical housing (32,33) capable of rotating about a non-rotating shaft (20). *See* col. 3, ln. 51-col. 4, ln. 28. An adapter (76) is rigidly fixed to the cylindrical housing (32,33). *See* col. 5, lns. 15-48 and Fig. 4. The device is actuated when a cam follower (83), coupled to the shaft (20), is forced vertically downward by a stationary cam track (84) such that the adapter frictionally engages the loose cap of container (12). *See* col. 5, lns. 15-48 and Figs. 2 and 4. The cylindrical housing (32,33) is rotated, along with the adapter (76), whereby the cap is tightened. *See* col. 5, lns. 15-48. ¶ The device of Heard at al. would not be able to tighten caps if combined with the clamp (24) of Pickel et al. Specifically, the clamp (24) of Pickel et al. would not be capable of rotatably securing a container cap when the clamp (24) moves vertically downward.”

However, while the device of HEARD ET AL lowers the openers vertically onto the bottle, the combination as explained above, would substitute the grippers and associated control units, as taught by PICKEL ET AL, and would therefore lower a gripper and control unit assembly together, so that the grippers and control unit would operate much as they do in PICKET ET AL, but in the environment and combination with HEARD ET AL.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.

/John Paradiso/

Examiner John Paradiso: (571) 272-4466

January 1, 2009

/Rinaldi I Rada/
Supervisory Patent Examiner, Art Unit 3721

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